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Attorney Docket No. 2001.45

JAN 12 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESIn re Application of:
Jaime Navarrete

Group Art Unit: 1745

Serial No. 10/664,147

Examiner: T. M. Dove

Filed: September 17, 2003

For: THE USE OF GRASS LIGNINS IN THERMOPLASTICS


VIA FACSIMILE
571-273-8300
Total Pages: 9REPLY TO EXAMINER'S ANSWER 37 CFR § 1.193Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply to Examiner's Answer is filed in response to the Examiner's Answer mailed November 17, 2005. It relates to the Appeal Brief as filed, August 22, 2005, in reply to the Office Action mailed June 9, 2005.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on January 12, 2006.


Jan Davis

Applicants note that in the Examiner's Answer the Examiner has acknowledged that: the (1) REAL PARTY IN INTEREST, (3) STATUS OF THE CLAIMS, (4) STATUS OF AMENDMENTS, (5) SUMMARY OF THE CLAIMED SUBJECT MATTER, (6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL, and (7) CLAIMS APPENDIX, are all correct. Further it is noted that Applicants provided a statement identifying (2) RELATED APPEALS AND INTERFERENCES.

Applicants note that there is no controversy on what the stated grounds of rejection are, the only issue in controversy is the Examiner's rejection of claims 1-7 and 9 as anticipated, under Section 102(b) over the Navarrete et al., WO 02/28955 A2.

There is no controversy that Navarrete et al., WO 02/28955 A2 mentions glass lignins in the background of the invention.

The only real question before the board is whether Navarrete et al., WO 02/28955 A2 teaches the use of grass lignins. Applicant an inventor, on the prior art reference claims that it does not.

Lignin as used repeatedly in the specification of Navarrete et al., WO 02/28955 A2 describe the lignin as a by product of wood

pulping operations, See Navarrete et al., WO 02/28955 A2, page 1, line 13, page 6, lines 12-13. It should be clear to one of ordinary skill in the art that grass lignins which are obtained from rice, corn or sugar cane are not a product of wood pulping operations. In the body of the application, under the detailed description of the invention, the prior art clearly states that lignins are "by-products of wood pulping operations" and that "[l]ignins include softwood lignins, hardwood lignins and combinations thereof." See Navarrete et al., WO 02/28955 A2, page 6, lines 12-16.

A. Consideration of the Prior Art in its Entirety

The prior art is good for everything it teaches, not just the invention it describes or claims. See *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir. 1985) ("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. On the issue of obviousness, the combined teachings of the prior art as a whole must be considered.")

By the same token, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of

other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In *re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed. Cir. 1986) (holding that the district court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness). In the *Navarrete et al.*, WO 02/28955 A2, reference, the Examiner is using a mention of the existence of grass lignins as a teaching, when it should be clear to anyone of ordinary skill in the art that, the reference in the background only acknowledged their existence, and attempted to explain how they are different chemically from the softwood or hardwood lignins of the *Navarrete et al.*, WO 02/28955 A2, invention.

The Question before the Board

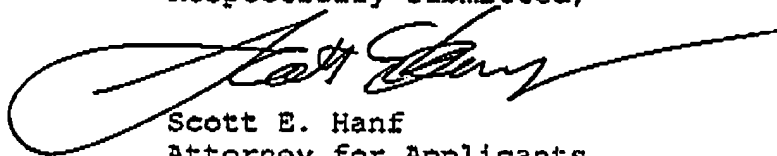
The only question before the Board is whether Navarrete et al., WO 02/28955 A2 teaches the use of grass lignins.

It should be unquestioned that Navarrete et al., WO 02/28955 A2, in the detailed description of the invention only teaches use of lignins as the by-products of wood pulping operations (page 6, lines 11, 12) and goes on to say that lignins include softwood lignins, hardwood lignins and mixtures thereof (page 6, lines 14 and 15). From this it should be clear that grass lignins, which do not come from wood pulping operations, are not taught.

Conclusion

In view of the foregoing, Appellants respectfully request that the rejection be overturned and that the instant application be allowed to proceed to issuance.

Respectfully submitted,



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SERIAL NO. 10/664,147
ART UNIT 1745

APPENDIX

1. (previously presented) A battery separator comprising:

a microporous membrane including
an ultra high molecular weight polyethylene,
a filler, and
a grass lignin.
2. (original) The separator of claim 1 wherein said grass lignin comprises about 5-20% by weight of said membrane.
3. (original) The separator of claim 2 wherein said grass lignin comprises about 5-10% by weight of said membrane.
4. (previously presented) The separator of claim 1 wherein said grass lignin source being selected from the group consisting of: bagasse, straw, abaca, sisal, flax, jute, hemp, and combinations thereof.
5. (original) A lead acid battery including the separator of claim 1.

6. (previously presented) A battery separator comprises:

a microporous membrane having an open cell structure with pores sizes in the range of about 0.1 to about 1 micron and porosity greater than 10%, and where said microporous membrane comprises:

about 15-25% by weight of an ultra high molecular weight polyethylene;

about 50-80% by weight of a filler;

about 5-20% by weight of a grass lignin.

7. (original) The separator of claim 6 wherein said filler being selected from the group consisting of precipitated silica, oxide compounds, and mixtures thereof.

8. (cancelled) ~~The separator of claim 6 wherein said oil being selected from the group consisting of mineral oil, olefinic oil, parafinic oil, naphthenic oil, aromatic oil, and mixtures thereof.~~

9. (previously presented) The separator of claim 6 wherein said grass lignin source being selected from the group consisting of: bagasse, straw, abaca, sisal, flax, jute, hemp, and combinations thereof.

10. (withdrawn) A thermoplastic polymer formulation comprising:

up to about 80% by weight of the formulation being thermoplastic polymer;

up to about 20% by weight of the formulation being a processing oil, and

up to about 10% by weight of the formulation being a grass lignin.

11. (withdrawn) The formulation of claim 10 wherein said polymer being a polyolefin.

12. (withdrawn) The formulation of claim 10 wherein said polymer being an ultrahigh molecular weight polyethylene.

13. (withdrawn) The formulation of claim 10 wherein said polymer includes a filler.

14. (withdrawn) The separator of claim 10 wherein said grass lignin being sourced from bagasse, straw, abaca, sisal, flax, jute, hemp, and combinations thereof.